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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,783	10/30/2003	Matthew R. Hackworth	68.0234DIV1	8883

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Schlumberger Technology Corporation
Schlumberger Reservoir Completions
14910 Ariline Road
P.O. Box 1590
Rosharon, TX 77583-1590

EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,783

Applicant(s)

HACKWORTH ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 11, 12, 25 and 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 and 23 is/are allowed.
- 6) ☒ Claim(s) 1, 7-10, 13, 15, 22, 24 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 2-4, 11, 12, 25, and 26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 15 October 2004.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 204. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “**Replacement Sheet**” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Δ L. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “**Replacement Sheet**” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because the abstract is not considered adequately descriptive of the disclosed and claim invention. Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Schetky et al. (US 2002/0046840)

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Schetky et al. discloses a system of expandable tubulars. The system includes the following features (paragraph [0047]-[0048]):

- A first bistable expandable tubular.
- A second bistable expandable tubular.
- A sand barrier (paragraph [0066]) that may be positioned either along the interior or exterior of the first and second tubulars.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 7-10, 13, 15, 22, 24, and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schetky et al. (US 2002/0046840) in view of Lohbeck (US 5,984,568).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claims 1, 10, 22, 29, 30: Schetky et al. discloses a system of expandable tubulars. The system includes the following features (paragraph [0047]-[0048]):

- A first bistable expandable tubular.
- A second bistable expandable tubular.
- A connector system for coupling the first tubular to the second.

Schetky et al. discloses all of the limitations of the above claims except for the connector system includes a plurality of interlocking extensions that have receiving extension and an insertion extension with the receiving extension having a narrow outer portion and a wider inner portion.

Lohbeck discloses a connector system for expandable tubing. The system includes a plurality of interlocking extensions with receiving extension and an insertion extension with the receiving extension having a narrow outer portion and a wider inner portion (Figure 3).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the system of Schetky et al. to include the connector system of Lohbeck in order to have eliminated the need to weld lengths of expandable tubing together thus avoiding the drawbacks of such connections (1:28-38).

Regarding claim 7: The system can include a sand barrier (paragraph [0066]).

Regarding claims 8, 9, 27, 28: The sand barrier may be positioned either along the interior or exterior of the first and second tubulars.

Regarding claim 13: The tubulars may be expanded along only a portion of its entire length.

Regarding claim 15: The system may include a second connector opposite the first.

Regarding claim 24: The interlocking extensions of Lohbeck are spaced, circumferential ridges.

Regarding claim 31: The system includes an expander that is run through a longitudinal opening in the first and second tubulars.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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11. Claims 1-4 and 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,648,071. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the above claims is essentially the same. The following claims in the instant application are essentially the same as the above claims in U.S. Patent No. 6,648,071:

- Claim 1 – Claims 1, 5, and 6.
- Claims 2-4 – Claims 2-4.
- Claims 7-9 – Claims 7-9.

Allowable Subject Matter

12. Claims 14 and 23 are allowed.

Response to Arguments

13. The cancellation of claims 5, 6, 16-21, and 35-54 has been noted.

14. Though the substance of the suggested drawing changes is considered acceptable to overcome the drawing objections made in the previous Office Action, those objections have been repeated because the changes were not presented as “Replacement Sheets” as specified above.

15. The objection to the abstract has been repeated merely because the amended abstract was submitted as a separate replacement page.

16. The remaining objection to the specification and the objection to the claims have been withdrawn in view of applicant’s amendment.

17. The rejection of claims 1-4 and 7-9 as being obvious-type double patenting of claims 1-9 of U.S. Patent No. 6,648,071 has been repeated as the claims have not been amended nor has a Terminal Disclaimer been filed.

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18. Applicant's arguments filed 28 February 2005 have been fully considered but they are not persuasive.

Applicant has argued that the instant application and the Schetky et al. reference are both based on the same U.S. provisional application filed on 24 January 2001 and that Schetky et al discloses that it is also based on Provisional Application No. 60/242,276 which was filed on 20 October 2000, however this earlier filed provisional application does not contain the disclosure to support the examiner's rejection of the claims. Therefore, Schetky et al. is not available as prior art under 35 USC 102(e).

The examiner notes that a thorough review of Provisional Application No. 60/242,276 revealed that, despite applicants' assertions, the disclosure of the provisional application and the Schetky et al. reference are nearly identical. The provisional application does not include the disclosure of the Schetky et al. reference from paragraph [0073] of the specification on but those paragraphs were not used by the examiner to reject the claims of the instant application. The provisional application is also missing Figures 4C and 4D of Schetky et al., however the subject matter shown in those figures is still disclosed in the specification of Provisional Application No. 60/242,276. Therefore, the Schetky et al. reference does qualify as prior art under 35 USC 102(e) and the rejection of the claims using this reference has been maintained.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

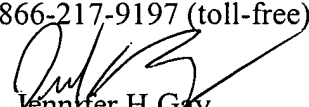
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer H Gay
Patent Examiner
Art Unit 3672

JHG 
May 5, 2005